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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/724,883	11/28/2000	John Edward Tomaschke	7703-PA02	6918
27111	7590	02/09/2004	EXAMINER	
BROWN, MARTIN, HALLER & MCCLAIN LLP 1660 UNION STREET SAN DIEGO, CA 92101-2926			MENON, KRISHNAN S	
			ART UNIT	PAPER NUMBER
			1723	

DATE MAILED: 02/09/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

eD

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	09/724,883	TOMASCHKE, JOHN EDWARD	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 29 August 2003.
- 2a) This action is **FINAL**.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 15-21,23,25 and 26 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 15-21,23,25 and 26 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. §§ 119 and 120

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) All    b) Some \* c) None of:  
1. Certified copies of the priority documents have been received.  
2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 13) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.  
a) The translation of the foreign language provisional application has been received.
- 14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

#### Attachment(s)

- 1) Notice of References Cited (PTO-892)                    4) Interview Summary (PTO-413) Paper No(s). 0104.  
2) Notice of Draftsperson's Patent Drawing Review (PTO-948)                    5) Notice of Informal Patent Application (PTO-152)  
3) Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.                    6) Other:

## DETAILED ACTION

Claims 15-21, 23, 25 and 26 are pending in this application.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 15-20, 25 and 26 are rejected under 35 U.S.C. 102(b) as being anticipated by Chau et al (US 4,983,291).

Chau (291) teaches a composite membrane comprising a supportive porous under-structure, a top layer of cross linked polyamide thin film on the top of a porous polysulfone support structure, the top layer having contacted with a sulfonic acid compound (sulfonic acid, toluene sulfonic acid, amine salt of sulfonic acid) whereby the membrane shows a salt rejection of at least 25% and flux of about 15 GFD as in instant claim 15 (working examples, col 4 line 51- col 8 line 21, especially col 6 line 58-68, and claims).

The porous backing is a polysulfone as in claim 18 (examples), with aromatic diamine as in claim 16, aromatic diacyl halide as in claim 17 (examples, claims), it is a thin film flat sheet as in claim 19 and spiral wound as in claim 20 (col 8 lines 10-12), sulfonic acid in water as in claim 25, and salt rejection better

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than 80% at flux greater than 5 GFD as in claim 26 (all in Chau: tables, working examples, col 4 line 51- col 8 line 21).

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 21 and 23, 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chau et al (US 4,983,291) in view of Koo et al (US 6,063,278).

Chau (291) teaches all the elements of claim 15. Claims 21 and 23 add further limitations of the species of sulfonic acids. Koo teaches methane sulfonic acid, ethane sulfonic acid and benzene sulfonic acid for making composite reverse osmosis membranes (see col 3 lines 30-37). It would be obvious to one of ordinary skill in the art at the time of invention to use the teaching of Koo in the teaching of Chau to make polyamide reverse osmosis membranes because Koo teaches that these sulfonic acids are equivalent for providing high flux, high rejection membranes (examples 1,2: Koo) that could be handled dry as taught by Chau (col 6 lines 58-68). A prima facie case of obviousness may be made when chemical compounds have very close structural similarities and similar utilities. "An obviousness rejection based on similarity in chemical structure and function entails the motivation of one skilled in the art to make a claimed compound, in

the expectation that compounds similar in structure will have similar properties."

In re Payne, 606 F.2d 303, 313, 203 USPQ 245, 254 (CCPA 1979). See In re Papesch, 315 F.2d 381, 137 USPQ 43 (CCPA 1963) (discussed in more detail below) and In re Dillon, 919 F.2d 688, 16 USPQ2d 1897 (Fed. Cir. 1991) (discussed below and in MPEP § 2144) for an extensive review of the case law pertaining to obviousness based on close structural similarity of chemical compounds. See also MPEP § 2144.08, paragraph II.A.4.(c).

***Response to Arguments***

Applicant's arguments filed 8/29/03 have been fully considered but they are not persuasive. The arguments submitted with the amendment have already been responded to in the advisory action.

***Conclusion***

This action follows an RCE, and is made non-final.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Krishnan S Menon whose telephone number is 571-272-1143. The examiner can normally be reached on 8:00-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wanda L Walker can be reached on 571-272-1151. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Krishnan Menon  
Patent Examiner

*Walker*  
W. L. WALKER  
SUPERVISORY PATENT EXAMINER  
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